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In re Application of :
Michelle F. Browner et al :
Application No. 10/004,287 :
Filed: October 23, 2001 :
Attorney Docket No. 018781-005710US :

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition, filed January 24, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee. This is also a decision on the petition, filed January 24, 2005, under 37 CFR 1.78(a)(6), requesting acceptance of an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of prior-filed provisional Application No. 60/243,581, filed October 26, 2000, as set forth in the amendments filed January 14, 2005 and supplemented on April 25, 2005 and in the Application Data Sheet (ADS) filed August 11, 2003.

The petition under 37 CFR 1.313(c)(2) is **DISMISSED** as moot.

The petition under 37 CFR 1.78(a)(6) is **GRANTED**.

Discussion of Petition under 37 CFR 1.313(c)(2)

Unfortunately, the instant petition was not received within sufficient time to avert issuance of the above-identified application into a patent. In this regard, the petition did not reach the deciding official's office until after issuance of the instant application into a patent.

Petitioner's attention is directed to 37 CFR 1.313(d), which states:

A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials **before the date of issue**.

Since a petition to withdraw the instant application from issue was not granted prior to issuance of the instant application into a patent, the request for continued examination (RCE) filed concurrently with the instant petition is improper and no fee has been charged.

Discussion of Petition under 37 CFR 1.78(a)(6)

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed provisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(6).

The instant nonprovisional application was pending at the time of filing of the reference to the prior-filed provisional application as required by 37 CFR 1.78(a)(5)(iii). Additionally, the instant nonprovisional application was filed within twelve months of the filing date of the prior-filed provisional application, Application No. 60/243,581, which was filed on October 26, 2000, for which priority is claimed.

The reference was made prior to issuance of the application into a patent; i.e., on August 11, 2003 in an ADS and on January 24, 2005. While the amendment received on January 24, 2005 included an improper incorporation by reference statement, the ADS received on August 11, 2003 was a proper reference to the prior-filed application, albeit an untimely reference. Further, as a result of the corrected claim for priority, a corrected Filing Receipt was issued on August 29, 2003. Therefore, the reference under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) to the prior-filed provisional application is considered to have been made prior to the issuance of the instant application into a patent.

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(6) in that (1) a reference to the above-noted, prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(5)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 119(e) to the above-noted, prior-filed provisional application satisfies the conditions of 37 CFR 1.78(a)(6), the petition is granted.

After this decision is mailed, deposit account No. 20-1430 will be charged \$130.00 for the petition under 37 CFR 1.313(c)(2) and \$1,370.00 for the petition under 37 CFR 1.78(a)(6).

Any inquiries concerning this decision may be directed to Wan Laymon at (571) 272-3220.

As this case has issued, and as the reference to the prior-filed application was properly made prior to issuance, it would be appropriate for issuance of a certificate of correction. Accordingly, in order to reflect the correct priority date on the front page of the Letters Patent, petitioner must submit a certificate of correction and pay the required fee of \$100.

Frances Hicks

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